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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,471	11/10/2003	Philip Zocco	G0718.70000US00	5730
23628 7590 02/28/2007 WOLF GREENFIELD & SACKS, PC FEDERAL RESERVE PLAZA 600 ATLANTIC AVENUE BOSTON, MA 02210-2206			EXAMINER CHAPMAN, JEANETTE E	
			ART UNIT 3635	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/28/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/705,471		ZOCCO, PHILIP	
	Examiner		Art Unit	
	Chapman E. Jeanette		3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6, 10, 11, 13, 18-20, 22-24, 26, 28, 29, 31-33, 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28, 29, 31, 32, 34-36, 4, 5, 18-20 and 26 is/are allowed.
- 6) ☒ Claim(s) 2, 3, 6, 10, 11, 13, 22-24 and 33 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 6, 10, 13, 22-24, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popovich et al (4337759). Popovich discloses an insert 10 and 440 which may be used for placement in a door light; The insert comprises

- A substantially planar top surface defining a plane; see annotations on patent copy
- A raised portion surrounded by the top surface; see annotations on patent copy
- The raised portion includes an outer edge and truncated sides provided on a portion and interrupting an outermost concentric ring such that the at least outermost concentric ring is incomplete; see annotations on patent copy
- The truncated side are provided on opposite positions of the outer edge of the raised portion and are parallel to one another
- The truncated side is perpendicular to the planar top side
- The planar top surface has a thickness, the raised portion has a maximum height; the maximum height is at least $\frac{1}{4}$ the thickness; see annotations on patented
- The raised portion including at least two features 530 which are raised with respect to the plane of the top surface;

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- The raised portion having a substantially uniform configuration; see figure 10a
- The raised portion defining an upper surface
- The at least two features on the raised portion include at least two raised concentric rings; Popovich discloses a fresnel lens; the definition of a fresnel lens is a lens with concentric ridged rings.
- a recessed portion at least partially surrounded by the bottom surface; see annotations on patent copy
- the recessed portion includes at least two features 532 which are recessed with respect to the bottom surface; see figure 7
- the recessed portion defining a lower surface; see annotations on patented copy
- at least two features on the recessed portion include two recessed concentric which substantially correspond in size and in shape to the at least two raised concentric rings on the raised surface; see figure 10a
- the distance between the upper surface of the raised portion and the lower surface of the recessed portion is substantially uniform throughout; see figure 10a
- the body 10 is formed of plastic (polyethylene) or glass
- the raised portion includes a bullseye configuration; see the definition of fresnel lens above
- a raised portion having a plurality of peaks wherein the maximum height of the peaks is substantially centered on the raised portion. A height of the peaks of the raised portion decreasing at a constant rate in a radial direction from the

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maximum height near the center toward an outer edge of the raised portion. See figure 1

- Wherein the at least two raised concentric rings include an inner ring and an outer ring, wherein the maximum height of the inner ring is substantially equal to the maximum height of the outer ring
- Wherein at least one of the concentric rings is a complete uninterrupted ring; see 10a definition of fresnel lens above

Popovich discloses a bottom surface spaced from and disposed substantially but not parallel relation to the top surface; the criticality of the substantially planar bottom surface parallel to the top is not seen; further one of ordinary skill in the art would have appreciated forming the mounting surface commensurate with the mounting structure to which it is attached.

See rejection above for other claimed limitations.

- The at least two raised concentric rings include an inner ring and an outer ring

The maximum height of the inner ring is greater than the maximum height of the outer ring. See figure 3

- Wherein the at least two raised concentric rings include an inner ring and an outer ring, wherein the maximum height of the inner ring is substantially equal to the maximum height of the outer ring
- Wherein at least one of the concentric rings is a complete uninterrupted ring; see 10a definition of fresnel lens above

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Claims 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popovich in view of Aho et al. (5097395).

Popovich discloses lacks the recited. Aho et al discloses a frame 12/14/16 having at least a part of the frame abutting an outer edge of the insert (fresnel lens) 24/26/27 to center the insert in the frame wherein the frame forms a central opening for exposing the raised portion of the insert

Allowable Subject Matter

Claims 4,5,18-20, 26, 35-36, 28-29, 31-32 are allowable over the prior art of record.

Response to Arguments

Applicant's arguments filed 11/29/06 have been fully considered but they are not persuasive. Most arguments are moot in view of the indicated allowability of many of the claims. However, for many of the remaining claims applicant is arguing intended use. In the remaining non-allowable claims nothing has been recited limiting the structures use to merely an insert for a door light. Further, recitations of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would

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have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that Popovich is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, lenses employed for light deflection or radiant energy by the use of peaks and valleys have many uses. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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Further, applicant states, "The at least two features on the recessed portion include at least tow raised concentric rings which substantially correspond in shape and size to the at least two raised concentric rings on the rings on the raised portion and the distance between the upper surface of the raised portion and the lower surface of the recessed portion" Applicant further states that "popovich does notdisclose a configuration where the recessed portion substantially corresponds in shape and size to the raised portion such that the distance between the upper and lower surface is "substantially uniform" How does one define substantially uniform; is the same partially uniform, mostly uniform?. The distance of Popovich is substantially uniform.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E. Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00, every fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Friedman Carl can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEANETTE E. CHAPMAN
PRIMARY PATENT EXAMINER
ART UNIT 3635

JEC